

REMARKS

With the addition of new claim 24, claims 12 to 24 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Applicants note with appreciation the acknowledgement of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, 1449 paper, and cited references. As to the previously disclosed references -- which were disclosed in the prior IDS, which were apparently not provided by the International Search Authority, Applicants submit herewith a Supplemental Information Disclosure Statement and PTO-1449 paper, which includes previously disclosed courtesy copies of European Patents Nos. 0 275 430 and 1 134 549, German Patent Application Publication No. 100 49 684, and International Patent Application Publication No. WO 98/38691. Accordingly, no fees are believed to be due.

Claims 12 to 21 were rejected under 35 U.S.C. § 102(b) as anticipated by German Patent Application Publication No. 199 62 997, which corresponds to U.S. Patent Application Publication No. 2002/0072869 (the "Stiller" reference). It is respectfully submitted that the "Stiller" reference does not anticipate any of claims 12 to 21 for at least the following reasons.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on

inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 12 relates to a method for calibrating sensors in a motor vehicle. Claim 12, which has been rewritten without prejudice to include some features of claim 14 as originally presented, provides that a calibration of at least two sensors includes using each of the at least two sensors to detect at least one part of a common calibration object. Regarding this feature, the Office Action asserts that “the object is detected using each sensor, and calibration data for the sensors is determined from data regarding the calibrations object (paragraphs 0021-0022).” Office Action, page 3. The cited section of the “Stiller” reference refers to data obtained with sensors 2 through 5 regarding a vehicle environment that includes “objects 6 or even groups of objects 6.” (“Stiller” reference, paragraph 21) The cited section does not identically disclose (or even suggest) that two or more of sensors detect a common calibration object, as provided for in the context of the claimed subject matter. Indeed, any review of the “Stiller” reference makes plain that it does not identically disclose (or even suggest) the feature of “calibrating at least two sensors . . . wherein the calibration includes using each of the at least two sensors to detect at least one part of a common calibration object,” as provided for in the context of claim 12. Accordingly, the “Stiller” reference does not identically disclose (or even suggest) each of the features of claim 12, so that the “Stiller” reference does not anticipate claim 12 or its dependent claims 13 to 17.

Claims 18 and 19 include subject matter similar to that discussed above as to claim 12, so that the “Stiller” reference does not anticipate either of claims 18 and 19 or its dependent claims, e.g., claims 20 and 21, as presented, for the same reasons as claim 12.

Withdrawal of the anticipation rejections of claims 12 to 21 is therefore respectfully requested.

Claims 22 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the “Stiller” reference and U.S. Patent No. 6,363,619 (the “Schirmer et al.” reference).

As regards the obviousness rejections of the claims, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 22 and 23 ultimately depend from claim 19, and are therefore allowable for the same reasons as claim 19, since the secondary “Schirmer” reference does not cure the critical deficiencies of the “Stiller” reference as to claim 19, as presented.

Furthermore, the Office Action asserts that “[i]t would have been obvious to modify Schirmer [*sic*] to use a triple mirror with calibration marks as taught by Stiller [*sic*] as a reference feature in order to reflect radar waves in the same direction as they came, and the calibration marks to help align the system correctly, therefore increasing the effectiveness of the calibration system.” (Office Action, page 4.) However, prior art references must be considered as a whole, including portions that teach away from the claimed subject matter. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

Furthermore, *prima facie* obviousness cannot be established based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, since there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The “Stiller” reference is directed to “guarantee[ing] permanent functional reliability [by] subsequent repeated checking of the calibration for possible changes” after calibration “is done in a laboratory-like environment.” (“Stiller” reference, paragraph 3.)

For this purpose, the “Stiller” reference provides for performing calibration using undetermined objects that happen to appear within the environment in front of the vehicle so that “no other equipment is necessary except for the essentially known sensor elements in the vehicle environment and an analyzer unit or calibration unit.” (“Stiller” reference, paragraph 6.) Thus, the “Stiller” reference specifically teaches away from using

predetermined calibration objects having particular features based on which to perform the calibration performed by the system of the "Stiller" reference. Indeed, such a calibration destroys the intent, purpose, and function of the "Stiller" reference.

For this additional reason, claims 22 and 23, as presented, are allowable.

Withdrawal of the obviousness rejection of claims 22 and 23 is therefore respectfully requested.

New claim 24 does not add any new matter and is supported in the specification. Claim 24 depends from claim 12, and is therefore allowable for the same reasons as claim 12, as presented.

Accordingly, all of pending claims 12 to 24 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that all of claims 12 to 24 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

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